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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

| Docket Number (Optional) |
|---|
| ITL.0597US (P11773) |

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on September 5, 2006

Signature

Typed or printed name Stephanie Petreas

| Application Number | Filed |
|---|---|
| 09/892,681 | June 27, 2001 |

| First Named Inventor |
|---|
| Michael D. Rosenzweig |

| Art Unit | Examiner |
|---|---|
| 2614 | William J. Deane, Jr. |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 42,117
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34

Signature

Mark J. Rozman
Typed or printed name

512-418-9944
Telephone number

September 5, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [x] *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant: | Michael D. Rosenzweig | § | Group Art Unit: | 2614 |
| | | § | | |
| Serial No.: | 09/892,681 | § | | |
| | | § | Examiner: | William J. Deane, Jr. |
| Filed: | June 27, 2001 | § | | |
| | | § | | |
| For: | Reducing Undesirable Audio Signals | § | Atty. Dkt. No.: | ITL.0597US (P11773) |
| | | § | | |

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Commissioner for Patents
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**REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicant seeks pre-appeal review of the rejection of claims 1-2, 5-6, 8-9, 12 and 18 under 35 U.S.C. § 102(e). Applicant also seeks pre-appeal review of the rejection of claims 19-27 and 30-38 under 35 U.S.C. § 103(a). It is respectfully submitted that the rejections to all pending claims are clearly erroneous and the burden of an appeal should be avoided.

Pending claims 1-2, 5-6, 8-9, 12 and 18 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Application No. 2001/0046304 (Rast). The rejection is clearly erroneous, as Rast fails to teach each and every element of the claims, as required for a proper anticipation rejection. With respect to claim 1, Rast fails to teach a control unit that both receives data from a storage unit and generates a first audio signal therefrom for output to a speaker of a portable device. In this regard, the only data stored in the system of Rast with respect to audio data are stored selection criterion corresponding to triggers of particular sounds in an ambient environment. *E.g.*, Rast, ¶17-18. To contend teaching of the claimed subject matter in Rast, the Examiner points to ¶22 of Rast (Final Office Action, p. 4). However, neither this paragraph nor any other part of Rast teaches that data received from a storage unit of a portable device in a control unit of the portable

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Stephanie Petreas

device is used to generate an audio signal for output to a speaker of the portable device. That is, the recited data and first audio signal is something other than a second audio signal that is generated to reduce undesirable noise. Instead all that ¶22 of Rast teaches is that triggering sounds are stored in a record memory of the headphones of Rast. Plainly, Rast does not teach that a control unit of a portable device receives data from a storage unit of the portable device and generates an audio signal therefrom for output to a speaker. Instead no output audio signals are generated from the triggering sounds stored in Rast. For at least these reasons, the rejection of claim 1 and its dependent claims is clearly erroneous.

As to independent claim 8, Rast nowhere teaches combining of two audio signals in a portable device in the manner recited by the claim, in clear violation of well-established patent law. Specifically, claim 8 recites that an analog audio signal converted from an audio signal stored in a storage unit of a portable device is combined with a second audio signal generated to reduce undesirable sound. As described above, Rast nowhere teaches storage of an audio signal that is then combined with a generated audio signal. Instead, any combining occurring in the headphones of Rast is between a noise cancellation signal generated in the headphones and an audio signal from another source – not an audio signal stored and converted in the headphones. Accordingly, the rejection of claim 8 and its dependent claims is clearly erroneous.

The rejection of pending claims 19-27 and 30-38 under 35 U.S.C. §103(a) over U.S. Patent Application No. 2002/0013784 (Swanson) in view of Rast is also clearly erroneous. As to claim 19, neither reference teaches or suggests a wireless phone that includes a storage medium to store at least one audio file. In this regard, Swanson merely discloses a cellular phone that can communicate data received from a server of a service provider. For teaching of a storage medium, the Examiner points to portions of Swanson referring to a storage unit at a user's PC or a service provider. Final Office Action, p. 3. However, such storage units have no bearing on the claimed storage medium of claim 19, which is a storage medium of a wireless phone. With regard to the Examiner's contention that "one of ordinary skill in the art would understand that *today* a PC is a phone and a phone is a PC" (Final Office Action p. 5, emphasis added), such argument misapprehends the correct analysis to be performed under §103, and instead clearly evinces the Examiner's erroneous reliance on improper hindsight reconstruction. That is, what one of ordinary skill in the art would understand today is irrelevant to the present application, which was filed in 2001.

The primary reference Swanson merely teaches a cellular telephone. Nowhere however does Swanson (or Rast) teach or suggest a control unit of the cell phone that combines first and second audio signals and provides the combined signal to a speaker of the cell phone. Nor is there any reason to combine Swanson with Rast, as there is no motivation in either reference to combine their teachings. That is, Rast merely teaches that to download stored selection criteria, a phone may be used. Rast, ¶19. Swanson, on the other hand is merely directed to a cellular phone that can be used in an audio data transmission system that includes cellular phones as receivers of transmissions. Even if combined, the references fail to meet the claimed subject matter.

In light of these disparate references, the Examiner has engaged in the hindsight-based obviousness analysis that has been widely and soundly disfavored by the Federal Circuit. In order to prevent a hindsight-based obviousness analysis, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab,* 55 U.S.P.Q.2d 1313, 1316-17 (Fed Cir. 2000). This requirement is lacking here. Instead, with respect to claims 19-27 and 30-38, the Examiner provides no factual support for the motivation, suggestion, or teaching of the manner in which Swanson and Rast must be modified to render obvious these claims. The conclusory statement that "it would have been obvious to incorporate the noise reduction elements of the headset as taught by Rast into the telephone of Swanson in order to have better communication quality" (Final Office Action, p. 3) fails to adequately set forth a proper motivation to combine. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2001). Because the Examiner fails to adduce any factual findings that would support a motivation for, or suggestion of, the combination of Swanson and Rast or the alchemy by which they might be modified to yield the subject matter of claims 19-27 and 30-38, a *prima facie* case of obviousness has not been made, and the rejection of the claims is clearly erroneous.

Since these rejections are clearly violative of existing PTO policy, the need for an appeal should be avoided.

Respectfully submitted,

Date: September 5, 2006

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